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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,705	10/05/2000	Jonathan Beckwith	HMV-052.01	8942

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EXAMINER

LOEB, BRONWEN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 04/21/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/679,705	BECKWITH ET AL.
Examiner	Art Unit	
Bronwen M. Loeb	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 05 February 2003 .

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-50,55 and 56 is/are pending in the application.

4a) Of the above claim(s) 1-28 and 49 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 29-42,44-48 and 50 is/are rejected.

7) Claim(s) 43,55 and 56 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: *Notice re: Revised Amendments Format*

## **DETAILED ACTION**

This action is in response to the amendment filed 5 February 2003 in which claims 29-33, 39-41, 43, 46 and 50 were amended.

Claims 1-50, 55 and 56 are pending.

### ***Election/Restrictions***

1. Claims 1-28 and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

### ***Claim Objections***

2. Claims 29 and 40-42 are objected to because of the following informalities:

Claim 29 is objected to for reciting "relative to cell" which phrase lacks the article "a", as in "relative to a cell".

Claim 40 is objected to for reciting "relative to cell" which phrase lacks the article "a", as in "relative to a cell".

Claim 41 is objected to for reciting " the *ahpC* gene which reduces its peroxidase activity"; the gene product possesses peroxidase activity, not the gene itself.

Claims 42 and 43 are objected to for not being amended to recite "the further modification" consistent with the amendment made to each of claims 39-41.

Appropriate correction is required.

***Response to Amendment***

3. The rejection of claims 29-48, 50, 55 and 56 under 35 USC §112, second paragraph, as being indefinite, has been withdrawn in view of Applicant's amendment.

The rejection of claims 55 and 56 under 35 USC §112, first paragraph, lack of enablement has been withdrawn in view of Applicant's amendment to the specification and the declaration from Jennifer Holmes.

4. Claims 29-42, 44-48 and 50 stand rejected under 35 USC §112, first paragraph, insufficient written description.

Claim 46 stands rejected under 35 USC §112, first paragraph, insufficient written description.

***Response to Arguments***

5. With regard to the rejection of claims 29-42, 44-48 and 50 under 35 USC §112, first paragraph, insufficient written description, Applicant's arguments have been fully considered but are deemed not persuasive.

Applicant argues that one of skill in the art, using well known methodologies, could readily identify mutations in the host gene or mutations in a gene that is later introduced into the host cell that increase the cell's ability to proliferate. Applicant further argues that one of skill in the art would be able to screen for other mutants in the AhpC protein that increase the proliferation rate. These arguments are not persuasive. While there may be methods available to screen for and identify the desired phenotype

and therefore mutation, such arguments, while possibly germane to an enablement rejection, are not germane to a written description rejection. The fact remains however that only one such mutation is disclosed in the specification (a specific mutation to the ahpC gene) and this single species is not a representative number of the entire genus. The specification does not suggest any other genes or the sites of mutation therein that would yield the desired increased proliferation. Applicant further argues that since the sequence of AhpC protein is known, one of skill in the art would be able to determine from the sequence which regions of the gene would be more likely to increase the catalytic activity. Applicant however does not disclose where in the specification or in the prior art the structure-function teachings necessary for one to determine from the sequence which regions of the gene would be more likely to increase the catalytic activity. There is no structure-function relationship disclosed in the specification for the ahpC gene so there is no guidance about where mutations should be made that would yield the desired phenotype. Thus, this argument is also not persuasive. The rejection is maintained.

6. With regard to the rejection of claim 46 under 35 USC §112, first paragraph, insufficient written description, Applicant's arguments have been fully considered but are deemed not persuasive.

Applicant argues that the specification discloses multiple methods of identifying thioredoxin variants having a redox potential that is higher than that of its wild-type counterpart. This argument is not persuasive. This argument, while possibly germane to an enablement rejection, is not germane to a written description rejection. The fact

remains that the specification is silent regarding structure-function teachings overall for the thioredoxin superfamily and other than the active site motif, does not teach where deletions or additions would yield increased redox potential or what types of substitutions would yield increased redox potential. Without structure-function teachings, one cannot envision all the variants that will increase the redox potential of any of the thioredoxin superfamily proteins. The rejection is maintained.

### ***Conclusion***

Claims 29-42, 44-48 and 50 are rejected. Claims 43, 55 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from 11:00 AM to 7:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached on (703) 305-1998.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Bronwen M. Loeb, Ph.D.  
Patent Examiner  
Art Unit 1636

April 16, 2003



JAMES KETTER  
PRIMARY EXAMINER

## Revised Notice\*

### AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT

The United States Patent and Trademark Office (USPTO) is permitting applicants to submit amendments in a revised format as set forth below. Further details of this practice are described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, signed January 31, 2003, expected to be published in *Official Gazette* on February 25, 2003 (Notice posted on the Office's web site at

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm> ). The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

Effective immediately, all applicants may submit amendments in reply to Office actions using the following format. Participants in the Office's electronic file wrapper prototype<sup>1</sup> receiving earlier notices of the revised practice may also employ the procedures set out below.

#### REVISED FORMAT OF AMENDMENTS

##### Begin on separate sheets:

Each section of an Amendment (e.g., Claim Amendments, Specification Amendments, Drawing Amendments, and Remarks) should begin on a separate sheet. *For example*, in an amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections must begin on a separate sheet. This will facilitate the process of separately indexing and scanning of each part of an amendment document for placement in an electronic file wrapper.

##### Two versions of amended part(s) no longer required:

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section or claim will be waived where an amendment is submitted in revised format below. The requirements for substitute specifications under 37 CFR 1.125 will be retained.

##### A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated – formerly claim #\_), (previously reinstated), (re-presented – formerly dependent claim #\_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.
- (2) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.
- (3) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

<sup>1</sup> The Office's Electronic File Wrapper prototype program is described in *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002) ("Prototype Announcement"), and applies only to Art Units 1634, 2827 and 2834.

- (4) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and shall not be underlined.
- (5) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

**Example of listing of claims (use of the word “claim” before the claim number is optional):**

Claims 1-5 (canceled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn)

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (re-presented – formerly dependent claim 11) A black bucket with a wooden handle.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (new): A bucket with plastic sides and bottom.

**B) Amendments to the specification:**

Amendments to the specification must be made by presenting a replacement paragraph or section marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per current 37 CFR 1.125.

**C) Amendments to drawing figures:**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with § 1.84. An explanation of the changes made must be presented in the remarks section of the amendment. Any replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should **not** be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Any questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to the following legal advisors in the Office of Patent Legal Administration (OPLA): Elizabeth Dougherty ([Elizabeth.Dougherty@uspto.gov](mailto:Elizabeth.Dougherty@uspto.gov)), Gena Jones ([Eugenia.Jones@uspto.gov](mailto:Eugenia.Jones@uspto.gov)) or Joe Narcavage ([Joseph.Narcavage@uspto.gov](mailto:Joseph.Narcavage@uspto.gov)). For information on the waiver or legal aspects of the prototype, please contact Jay Lucas ([Jay.Lucas@uspto.gov](mailto:Jay.Lucas@uspto.gov)), Senior Legal Advisor (PCTLA) or Rob Clarke ([Robert.Clarke@uspto.gov](mailto:Robert.Clarke@uspto.gov)), Senior Legal Advisor (OPLA). Alternatively, further information may be obtained by calling OPLA at (703) 305-1616.

\* Revised Notice: See Sec. B) for changes relating to substitute specifications, and Sec. C) for changes on replacement drawing practice.